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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)
2646-000001

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Application Number
10/693,136Filed
October 24, 2003First Named Inventor
David M. Allen

On December 29, 2005

Art Unit
3643Examiner
Son T. NguyenSignature 

Typed or printed name Michael D. Zalobsky

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

applicant/inventor



Signature

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)

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December 29, 2005

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

*Total of _____ forms are submitted.



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No.: 10/693,136
Filing Date: October 24, 2003
Applicant: David M. Allen
Group Art Unit: 3643
Examiner: Son T. Nguyen
Title: PROTECTIVE GROUND MAT
Attorney Docket: 2646-000001

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

In response to the Final Office Action mailed September 29, 2005, please consider the remarks set forth below.

Claims 1-19 are pending in the application. Claims 17-19 have been rejected under 35 U.S.C. §103(a) as being unpatentable over USPN 6128852 (Hansen) in view of USPN 5070643 (Hinsperger), Claims 5, 7, 8, 10-16 have been rejected under 35 U.S.C. §103(a) as being unpatentable over USPN 3750731 (Brimmell) in view of USPN 5085001 (Crawley) and USPN 6705044 (Clancey), and Claim 6 has been rejected under 35 U.S.C. §103(a) as being unpatentable over USPN 3750731 (Brimmell) in view of USPN 5085001 (Crawley) and USPN 6705044 (Clancey) and further in view of USPN 5058317 (McMurtney).

Applicant respectfully submits that the Office has not presented a *prima facie* case of obviousness and as such, the review of this submission in a panel review is appropriate.

Regarding the rejection of Claims 17-19 under 35 U.S.C. §103(a) as being unpatentable over USPN 6,128,852 to Hansen in view of USPN 5,070,643 to Hinsperger, Applicant initially notes that Hansen appears to disclose a landscaping tarp that may be positioned about a bush or small tree to permit cut leaves and twigs to fall and collect thereon as the bush or tree is trimmed. Figure 3 of Hansen illustrates the tarp in a condition wherein leaves and twigs are being carried off after cutting has been completed.

Applicant next notes that Hinsperger appears to be directed to a device and method for grass restoration and seed germination. Hinsperger employs a removable cover (2) that can be selectively coupled to the ground via a plurality of U-shaped wire stakes (8). Hinsperger notes that in areas of high wind, plastic loop members (10) may be coupled to the cover (2) and that ropes (12) may be received through holes in the plastic loop members (10) and secured at opposite ends to the stakes (8). Applicant notes that the ropes (12) of Hinsperger do not tension or adjust the size and/or shape of the perimeter of the panels (4) that make up the cover (2), but rather simply lie across the panels (4) in a manner that limits the movement of the cover (2). Applicant notes that the rope may be able to apply a compressive force to the surface of the panels, but it does not appear to be possible to apply tension through the rope.

In contrast, Claim 17 is directed to a method that includes "tensioning the base after it has been secured to the ground so that it conforms to a contour of the ground". As such, Applicant submits that the Examiner has not presented a *prima facie* case of obviousness in that there is no suggestion in the art for the combination of the Hansen and Hinsperger references and that each limitation of Claim 17 is not taught or suggested by the combination of Hansen and Hinsperger.

Regarding the suggestion for the combination, Applicant notes that as the Hansen tarp is configured to be placed about a tree or bush just prior to a trimming operation and removed

therefrom immediately after the trimming operation, there is no need or suggestion in these references to employ the stakes and rope of Hinsperger reference. In this regard, the stakes and rope of Hinsperger would be undesirable in that they would impede efficient removal of the tarp. Moreover, as the rope of Hinsperger does not appear to be capable of applying tension to the tarp of Hansen, it is not a tensioner. The combination of the Hansen and Hinsperger references, therefore, does not teach or suggest a method that includes tensioning the base after it has been secured to the ground as recited in Claim 17. Accordingly, Applicant submits that the Examiner has not presented a *prima facie* case of obviousness and as such, respectfully requests that the Examiner reconsider and withdraw the rejection of Claims 1 and 17 under 35 U.S.C. §103(a). Applicant notes that Claims 18 and 19 depend from Claim 17 and as such, Applicant submits that these claims are in condition for allowance for the reasons set forth for Claim 17, above.

Regarding the rejection of Claims 5, 7, 8, & 10-16 under 35 U.S.C. §103(a) as being unpatentable over USPN 3750731 (Brimmell) in view of USPN 5085001 (Crawley) and USPN 6705044 (Clancey), Applicant initially notes that the '731 patent is directed to a bag for disposing of a Christmas tree, whereas the '001 and '044 patents are directed to mulch skirts and root covers, respectively. Applicant respectfully asserts that the '731 patent does not disclose a protective ground cover device, nor does it relate to the field of the present invention or a field reasonably pertinent to the resolution of the problem being solved by the present invention. Consequently, the '731 patent is not analogous art and cannot be properly combined with the '001 and/or '044 patents or cited as prior art. However, even if the '731 patent were classified as analogous art, its combination with the '001 and '044 patents would still be improper as the Examiner has not presented evidence of some teaching, suggestion or incentive supporting the combination and the cited combination of references does not teach or suggest all elements/limitations of the claims.

For example, the '044 reference employs a pair of "cords 38, 44 that are pulled to wrap and secure the upper portion of the cover around a tree, shrub or plant" rather than to "tension" the adjustable root cover. Applicant further notes that the Patent Laws draw a distinction between trade-offs and motivation to combine: trade-offs often concern what is feasible, not what is necessarily desirable, whereas motivation to combine requires the latter. The Examiner has stated that the motivation to include tensioners on the disposable bag of the '731 patent "to assure that the tensioners will not slip through the base from the sleeve containing the tensioners." Applicant submits that the rationale advanced by the Office is a trade-off rather than motivation to combine because it would not be desirable to tension the disposable bag of the '731 patent.

Regarding the '001 patent, the Examiner has stated that one of ordinary skill in the art would have been motivated to employ the anchor pins (27) of the '001 patent in conjunction with the disposable bag of the '731 patent "in order to prevent the mat from moving". Applicant respectfully submits that the driving of anchor pins into the floor adjacent a Christmas tree to hold a disposable bag in place concerns what is feasible (i.e., it is a trade-off) and not what is necessarily desirable.

In summary, Applicant respectfully submits that the Office has not set forth a *prima facie* case of obviousness as a) the '731 patent is non-analogous art, b) there is no motivation to combine either the '044 patent or the '001 patent with the '731 patent, and c) the cited combination of references does not teach or suggest all elements of the claims (e.g., a tensioner). As such, Applicant respectfully requests that the Office reconsider and withdraw the rejection of Claims 5, 7, 8, & 10-16 under 35 U.S.C. §103(a).

Regarding Claim 6 under 35 U.S.C. §103(a) as being unpatentable over USPN 3750731 (Brimmell) in view of USPN 5085001 (Crawley) and USPN 6705044 (Clancey) and further in view of USPN 5058317 (McMurtney), Applicant incorporates by reference the above discussion as it applies to Claim 5. Applicant notes that the '317 patent does not teach or suggest a slit

that terminates a series of perforations or perforations that define a plurality of intersecting lines. In this regard, the '317 patent discloses a slit (22 in Fig. 2, 52 in Fig. 4 and 66 in Fig. 5) that intersects a second slit (36 in Fig. 2, 54 in Fig. 4 and 66 in Fig. 5). Moreover, the Examiner has stated that it would have been obvious to employ a plurality of intersecting lines as taught my McMurtrey "in order to hug tightly around the object to be surrounded". Applicant notes, however, that such construction would eliminate the collar of the disposable bag that is disclosed in the '731 patent. Applicant submits that this modification of the '731 patent would be undesirable as it would eliminate the folds (20) of material that are employed to surround the Christmas tree during disposal. In summary, Applicant respectfully submits that the Office has not set forth a *prima facie* case of obviousness as a) the '731 patent is non-analogous art, b) there is no motivation to combine either the '044 patent, the '001 patent or the '317 patent with the '731 patent, and c) the cited combination of references does not teach or suggest all elements of the claims (e.g., a perforations that intersect). As such, Applicant respectfully requests that the Office reconsider and withdraw the rejection of Claims 5, 7, 8, & 10-16 under 35 U.S.C. §103(a).

CONCLUSION

Prompt and favorable consideration of this request is respectfully requested. If the Office believes that personal communication will expedite prosecution of this application, the Office is invited to telephone the undersigned at (248) 641-1600.

Respectfully submitted,

By: 
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